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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/693,204      | 10/19/2000  | Janet A. Warrington  | 3240.1              | 7262             |

22886 7590 06/06/2003

AFFYMETRIX, INC  
ATTN: CHIEF IP COUNSEL, LEGAL DEPT.  
3380 CENTRAL EXPRESSWAY  
SANTA CLARA, CA 95051

EXAMINER

JOHANNSEN, DIANA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/693,204

Applicant(s)

WARRINGTON ET AL.

Examiner

Diana B. Johannsen

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 27 February 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 10-13.

Claim(s) rejected: 10-13.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



Continuation of 5. does NOT place the application in condition for allowance ~~because~~: for the reasons set forth on the Attachment to this Advisory Action and for the reasons of record in view of the non-entry of the After Final amendment.

**ATTACHMENT TO ADVISORY ACTION**

***New issues raised.***

1. Applicant's proposed amendments raise new issues under 35 USC 103 that would require further search and consideration. Applicant has proposed amending claim 13 so as to require the simultaneous measurement of "said gene" and at least ten maintenance genes. Accordingly, Applicant's proposed amendments would necessitate further search and consideration of whether methods requiring such simultaneous measurement are obvious.

***Claim Rejections - 35 USC § 112 – Response to Arguments***

2. Regarding the rejection of claims 10-13 over the recitation of the list of maintenance genes set forth in claim 13, the response argues that it is "readily apparent to a person skilled in the art that both protein and mRNA names may be used to define a gene" and further argues that "the claim does not specify whether protein or mRNA levels are being measured." This argument is not persuasive. While applicant appears to be arguing that, e.g., the recitation of the protein name "profilin" and of the term "thymosin beta-4 mRNA" each encompass both protein and mRNA molecules, the term "profilin" is well-known to those of skill in the art as the name of a protein, and the use of the term "mRNA" in the recitation "thymosin beta-4 mRNA" clearly indicates a particular type of molecule (i.e., mRNA). While terms such as "profilin" and "thymosin beta-4 mRNA" do in fact have well-known meanings, the claims are indefinite because it is unclear as to whether the claims as written are intended to be limited to these particular known molecules or whether the claims are intended to encompass something broader

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(e.g., any expression of a gene corresponding to these particular proteins/mRNA molecules). It remains unclear as to what the claims are intended to encompass.

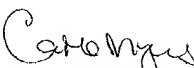
**Conclusion**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at 703/308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0196.

Diana B. Johannsen  
June 4, 2003

  
CARLA J. MYERS  
PRIMARY EXAMINER